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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,333	08/04/2003	Guenter Berschel	FA1194USNA	6771

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LEGAL PATENT RECORDS CENTER
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WILMINGTON, DE 19805

EXAMINER

TSOY, ELENA

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/634,333	Applicant(s) BERSCHEL ET AL.	
	Examiner Elena Tsoy	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/4/2003.
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
 4a) Of the above claim(s) 2,7,8 and 10 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1,3-6,9 and 11 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/4/03</u> . | 6) <input type="checkbox"/> Other: _____ |

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Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 3-6, 9, 11, drawn to a method for multi-coat re-finishing, classified in class 427, subclass 407.1.
 - II. Claims 2, 7, 8, 10, drawn to a method for multi-coat re-finishing, classified in class 427, subclass 407.1.

Distinctness

The inventions are distinct, each from the other because:

2. Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different modes of operation, different functions because in invention I, a solvent-based coating is applied first followed by a water-based coating whereas in invention II a water-based coating followed by a solvent-based coating.
3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Hilmar L. Fricke on July 22, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1, 3-6,9, 11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2, 7, 8, 10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 9, 11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Anderson et al (US 6,592,999).

Anderson et al disclose a method of forming multi-layer color-plus-clearcoating systems for automotive applications, with improved interlayer adhesion for easy repair of defects in clear coats or basecoats (See column 5, lines 1-50). The method comprises applying to a substrate precoated with an electrocoat primer, a primer/surfacer and a basecoat by spray application with gray (claimed solid color) solventborne primer (claimed first coat of paint) and a waterborne silver (claimed metallic effect pigment) basecoat, applying powder clear coating compositions to

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the the basecoat (See column 62, lines 22-48). The interlayer adhesion is improved by inclusion of adhesion promoters into conventional coating composition (See column 5, lines 1-10).

Clearly, all three-layer coatings can be used for refinishing because of the improved interlayer adhesion between any of the layers, or it would have been obvious to one of ordinary skill in the art to have refinished the car painting using all three layer coatings depending on defects.

9. Claims 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al in view of Kubitza et al (US 5075370) and Briselli et al (US 5,466,286).

Anderson et al are applied here for the same reasons as above. Anderson et al fail to teach that the solventborne primer is two-component coating composition containing polyisocyanates as cross-linking agents.

Kubitza et al teach that highest quality chemically cross-linking polyurethane paints such as organic solvent based two-component polyurethane paints based on polyisocyanates containing free isocyanate groups are extensively used in the coating field (See column 1, lines 18-25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used organic solvent based two-component polyurethane paints based on polyisocyanates containing free isocyanate groups as solventborne two-component primer in Anderson et al since Kubitza et al teach that highest quality chemically cross-linking polyurethane paints such as organic solvent based two-component polyurethane paints based on polyisocyanates containing free isocyanate groups are extensively used in the coating field.

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Briselli et al teach that commercial solventborne two-component polyurethane primer can be used for priming substrates before applying a water-based base coat (See column 8, lines 25-36).

One of ordinary skill in the art at would have reasonable expectation of success of using teaching of Kubitza et al because Briselli et al teach that commercial solventborne two-component polyurethane primer can be used for priming substrates before applying a water-based base coat.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al in view of Kubitza et al and Briselli et al, further in view of Schlaak (US 5,976,343).

Anderson et al in view of Kubitza et al and Briselli et al are applied here for the same reasons as above. Anderson et al in view of Kubitza et al and Briselli et al fail to teach that both the solvent-based coating composition and the water-based coating composition are solid-color basecoats pigmented with colour-imparting absorption pigments.

Schlaak teaches that both primer and basecoat can be formulated only with colour-imparting absorption pigments (See column 3, lines 22-46; column 6, lines 4-5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used colour-imparting absorption pigments in both primer and basecoat layers of Anderson et al since Schlaak teaches that both primer and basecoat can be formulated only with colour-imparting absorption pigments.

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Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur..9:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-141523. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy
Primary Examiner
Art Unit 1762

**ELENA TSOY
PRIMARY EXAMINER**
ETsoy

July 22, 2005